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In re Application of :
JANNES et al : Decision on Petition
Serial No.: 09/787,000 :
Filed : 13 March 2001 :
Attorney Docket No.: 2551-58 :

This letter is in response to the Petition under 37 C.F.R. 1.181 filed on 18 June 2004 and then refilled on 6 May 2006 requesting review of the restriction requirement. The delay in acting upon this petition is regretted.

BACKGROUND

A review of the file history prior to 23 October 2003, may be found in the "Decision on Petition" issued on 18 June 2004.

On 7 November 2005, the examiner set forth a non-final Office action in which claims 13-49 were pending, claims 37-49 were withdrawn from examination as being directed to non-elected inventions, claims 13-16 and 18-34 were rejected and claims 17, 35 and 36 were objected to.

On 8 May 2006, applicants filed a response, an amendment to the claims and refiled this petition.

DISCUSSION

The file history, application and petition have been considered carefully. This application is the national stage filing of a PCT application and as such is entitled to unity of invention rules under PCT.

The petition requests reconsideration of the withdrawal of claims 37-41, 43-46 and 48-49 because applicants argue "the examiner has indicated that the products of these claims (i.e., the primers according to claims 17 (and 36) have been examined and are allowable." This is not so. On page of the Office action mailed 7 November 2005, the examiner stated:

> Claims 17, 35 and 36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
>
> The prior art does not teach or suggest the primer pairs recited for each of the pathogens in claim 17, i.e., SEQ ID NOs: 17-21 and 35-52.

In response to this action, on 8 May 2006, applicants filed an amendment to the claims, however, this amendment did not address the outstanding claim objections. It is noted that claims 17 currently depends upon claim 13, claim 35 currently depends upon claim 17 and claim 36 currently depends upon claim 15. The allowability of claims 17, 35 and 36 was contingent upon these claims being rewritten in independent form, including all the limitations of the base claim and any intervening claims. Applicants have not amended the claims, as suggested, to place them in condition for allowance. Nor did the amendment of 8 May 2006 limit the base or intervening claims to the primer pairs recited for each of the pathogens in claim 17, i.e., SEQ ID Nos 17-21 and 35-42.

Further, a review of withdrawn claims 37-41, 43-46 and 48-49 show that none of these claims are limited in scope to the primer pairs recited for each of the pathogens in claim 17, i.e., SEQ ID Nos 17-21 and 35-42.

At this point in time, it is premature to consider allowability of any elected claims or rejoinder of any withdrawn claims.

The petition then requests clarification as to the lack of unity determination for Group II, III and IV. It is noted that Groups II, III and IV are withdrawn from examination because applicants elected the process of Group I.

Moreover, this application is a national stage filing under 35 USC 371 and as such, is entitled to unity of invention rules for PCT practice as set forth in Chapter 1800 of the MPEP. A single PCT application may result in the filing of only one single national stage application, although other applications maybe filed under 35 USC 111(a) which claim priority back to the

PCT application. Any application filed under 35 USC 111(a), whether it is a continuation of a PCT application or a continuation or divisional of a national stage application, is entitled to restriction practice in Chapter 800 of the MPEP.

PCT Rule 13.2 states that unity of invention is present when the inventions, taken as a whole, share a technical feature which makes a contribution over the prior art. In this application, the examiner found that unity is lacking between the process invention (Group I) and various product (Group II, III and IV) inventions because the groups were no so linked by a technical feature that makes a contribution over the prior art. That assertion holds true as evidenced by the fact that the elected, pending claims are rejected under 35 USC 103(a) as being unpatentable over a combination of references. If the elected invention, *taken as a whole*, is not novel or unobvious, any technical feature required by all the claims of the elected invention and all the claims of the non-elected invention would also not make a contribution over the prior art, either.

The examiner found unity of invention lacking between product and process inventions. Rejoinder opportunities exist when applicants elect the product, the product invention is found allowable and all the claims to the process of using or making the product depend from or otherwise require all the limitations of an allowable product claim. The rationale for this type of rejoinder is that any method of making or using a novel product would also typically be considered novel and unobvious. That typical form of rejoinder practice does not apply true here, where applicants have elected the process invention.

However, for national stage filings under 35 USC 371, unity of invention is reconsidered during prosecution. Should all of the elected and currently pending process claims in this instant application become allowable, (and at this point in time, none of the process claims are in condition for allowance) the examiner will look to see if the withdrawn claims require any special technical feature set forth in the allowable claims. If so, withdrawn claims that are limited to scope to special technical feature set forth in the allowable claims will be considered for rejoinder and the lack of unity determination may be withdrawn, in full or in part, to correspond to any rejoinder that occurs.

If applicants wish to pursue the product inventions in a subsequent application, which would have to be filed under 35 USC 111(a) because only one national stage filing is permitted for a single PCT, the non-elected product inventions would be subject to restriction practice under Chapter 800 of the MPEP. It is premature at this time to discuss how the product inventions, if filed in a subsequent application under 35 USC 111(a), would be treated under US restriction practice.

DECISION

Accordingly, the petition is **DENIED**. The lack of unity determination and examination practice is correct for the type of application, election, and claims under examination, as they are currently amended.

The application will be forwarded to the examiner to consider the papers filed 8 May 2006 and for further action consistent with this decision. Applicants also request a fully initialed copy of the PTO 1449 form filed 13 March 2001.

Any request for reconsideration must be filed within two (2) months of the mailing date of this decision.

Should there be any questions regarding this decision, please contact Quality Assurance Specialist/Program Manager Julie Burke, by mail addressed to Director, Technology Center 1600, PO BOX 1450, ALEXANDRIA, VA 22313-1450, or by telephone at (571) 272-1600 or by Official Fax at 571-273-8300.

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